

REMARKS

The Office Action of September 30, 2004 has been carefully reviewed and these remarks are responsive thereto. Claims 1-40 are pending. Claims 1, 11, 23, 15, 27, 33 and 36-37 have been amended. No new matter has been added. Entry of the amendments and reconsideration and allowance of the instant application are respectfully requested.

Claim Rejections

Claims 1, 5-8, 11, 13 and 27-30 stand rejected as being anticipated by Merrien *et al.* (WO 98/57474) (hereinafter "Merrien"). This rejection is respectfully traversed for the following reasons.

Claim 1 recites, *inter alia*, "configuring the network access device using said configuration settings such that network communication is initially established between the network access device and a network operator." Merrien fails to teach or suggest using configuration settings such that network communications is initially established between the network access device and a network operator. At most, Merrien discloses a method and system for storing an Internet provider's address, an IP address and a card user's other personal Internet data on a smart card and using a terminal to explore the stored data on the card *when the terminal is connected to the Internet*. See Abstract. Nowhere does Merrien suggest or mention *initially* connecting a network access device to a network *operator*. As such, it is clear that Merrien does not contemplate establishing network connectivity by using configuration settings such that network communication is initially established between the network access device and a network operator, as is recited in claim 1. Claim 1 is thus allowable for at least this reason.

Claims 5-8, 11 and 13 are dependent on claim 1 and are thus allowable for at least this reason and further in view of the novel and non-obvious features recited therein.

In addition, the features of claims 6 and 7 are mutually exclusive. Therefore, Merrien can not teach both features because Merrien only describes a single embodiment. Claim 6 recites, *inter alia*, "inserting said data storage card into a data storage card reader in the network access device." Claim 7, on the other hand, recites, *inter alia*, "inserting said data storage card into a data storage card reader in a *computer* connected to the network access device." *Emphasis*

added. Therefore, if, *arguendo*, Merrien taught the features of claim 6, Merrien would teach away from the features of claim 7, and *vice versa*. As such, claims 6 and 7 are allowable for this additional reason.

Claim 27 recites, *inter alia*, a “data storage card reader for loading said configuration settings from said data storage card into said network access device, said configuration settings for configuring said network access device to initially establish network communication between said network access device and said network operator.” For similar reasons as discussed with respect to claim 1, Merrien does not teach or suggest such a feature. Merrien does not disclose using configuration settings to initially establish network communications between a network access device and a network operator. Claim 27 is thus allowable for at least this reason.

Claims 28-30 are dependent on claim 27 and are thus allowable for at least the same reasons as claim 27 and further in view of the novel and non-obvious features recited therein.

In addition, claim 29 recites, *inter alia*, “software that controls the loading of said configuration settings into said network access device.” Merrien fails to teach or suggest such a feature. At most, Merrien discloses an explorer that uses personal Internet data stored on a smart card when a terminal is connected to the Internet. However, Merrien still lacks any suggestion of software that controls the loading of configuration settings. Claim 29 is thus allowable for this additional reason.

Claim 30 recites, *inter alia*, “the system of claim 29 wherein said software resides in a computer in communication with said network access device.” Not only does Merrien fail to teach or suggest such software (discussed with respect to claim 29), Merrien also does not teach or suggest that the software resides in a computer in communication with said network access device. In supporting the rejection, the Examiner refers to the abstract and figure of Merrien. Office Action, p. 4. However, neither illustrates or discloses any software residing in a computer in communication with said network access device. As such, claim 30 is allowable for this additional reason.

Claims 2-3 and 33-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien as applied to claims 1 and 27 above, and further in view of Liu *et al.* (U.S. Patent No. 6,081,517) (hereinafter “Liu”).

Claims 23 and 25-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and Examiner’s Official Notice and further in view of Liu.

These rejections in view of Liu are respectfully traversed for the following reasons.

Liu generally relates to a digital subscriber loop access and multiplexing (DSLAM) circuit for use at a central office site. More specifically, Liu discloses a DSLAM circuit that couples to a digital subscriber loop (DSL) and permits a user to set up and configure an end-to-end connection with destination customer premise equipment. However, Liu does not teach or even suggest the use of a smart card to provide configuration settings for a network access device.

The Office Action fails to offer any evidence why one of ordinary skill in the art would be motivated to combine Merrien and Liu. The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). The Office Action only offers that the combination would have been obvious “to allow a client to connect to a destination content premise system (or ISP) through DSL.” Yet, Merrien does not suggest or relate to the actual configuration of a network access device to access a network operator. Merrien merely discloses using personal data stored on a smart card (SIM) when accessing the Internet using a cordless phone. *See* Abstract; *see also* FIG. 1. The alleged motivation is merely the end-result of a combination made in view of hindsight considerations. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant’s disclosure. The Office Action is

improperly and impermissibly using Applicants' invention as a blueprint, and claims 2-3, 23, 25-26 and 33-34 are allowable for at least this reason.

Claims 9 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and further in view of Riggins (U.S. Patent No. 6,233,341).

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and Examiner's Official Notice and further in view of Riggins.

These rejections in view of Riggins are respectfully traversed for the following reasons.

Riggins generally relates to a system and method for installing a using a temporary certificate at a remote site. In particular, Riggins discloses using temporary certificates for verifying the identity of a particular access user. Col. 1, ll. 54-67. The system and method further involves the use of public and private keys to ensure authenticity of sent and received data.

In order to rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. MPEP §2141.01(a). Riggins fails to satisfy this requirement and thus, the Examiner's use of Riggins as a basis for rejection is improper. According to the Federal Circuit, the applied reference "must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). As discussed above, Riggins deals exclusively with client and server authentication and the authentication of transmitted information through the use of temporary certificates. Applicants' invention, on the other hand, teaches a method and system of configuring a network access device, using a data storage card, to establish network communications between the access device and a network application provider. Nowhere does Riggins mention or even suggest configuration of a network access device to establish network communications. As such, the fields of endeavor of Applicants' invention and the Riggins invention are entirely different. Similarly, Riggins' method of user and data authentication is not reasonably pertinent to the Applicants' problem of allowing users to configure network access device. Riggins would not have logically "commended itself to [the] inventor's attention in considering his problem." *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). As such, Applicants respectfully requests the withdrawal of Riggins as a basis of rejection for at least this

reason. In addition, even if combined, Riggins does not cure the deficiencies of Merrien. Claims 9, 21 and 32 are thus allowable for at least these reasons.

Even assuming, without admitting, that Riggins is analogous art, the combination with Merrien still lacks motivation. The Examiner states that it would have been obvious “to use Riggins’ method for installing a private key into Merrien’s system.” Additionally, the Examiner argues that the motivation to do so would be to “have the ability to authenticate the user.” Again, the Examiner is merely stating the end-result of the combination using impermissible hindsight considerations. Merrien lacks any suggestion regarding authentication or the use of temporary certificates and private keys. Likewise, Riggins does not even mention the use of or need for insertable smart cards in a terminal equipped with an explorer. The Examiner is merely using Applicants’ invention as a blueprint. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant’s disclosure. Claims 9, 21 and 32 are thus allowable for this additional reason.

Claims 10, 15-19 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and further in view of Examiner’s Official Notice. This rejection is respectfully traversed for the following reason.

Claim 15 recites, *inter alia*, “configuration settings configuring the network access device to initially establish network communication between the network access device and the network operator.” As discussed previously with respect to claims 1 and 27, Merrien fails to teach or even suggest configuring the network access device using configuration settings such that network communication is initially established between the network access device and a network operator. Examiner’s Official Notice fails to cure this deficiency. Claim 15 is thus allowable for at least this reason. Claims 10, 16-19 and 36 are allowable for at least the same reasons as their respective base claims.

Claims 12 and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and further in view of Decker et al. (U.S. Patent No. 4,757,495) (hereinafter “Decker”).

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and Examiner’s Official Notice and further in view of Decker.

These rejections in view of Decker are respectfully traversed for the following reasons.

Decker generally relates to apparatus and method for the simultaneous transmission of analog speech and modulated data. *See* Abstract. More specifically, Decker discloses optimizing such an apparatus and method for use over impaired and bandwidth restricted analog channels. *Id.*

As discussed previously, an applied reference “must either be in the field of Applicants’ endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 24 USPQ2d at 1445. Decker fails to satisfy any of these requirements. Decker’s field of endeavor relates to the optimization of simultaneous transmission of analog speech and modulated data. *See* Abstract. In contrast, Applicants’ invention teaches a system and method for configuring network access devices using a data storage card. Specification, p. 2, ll. 8-20. As such, Applicants’ invention and Decker’s invention clearly do not fall within the same field of endeavor. Moreover, Decker is not reasonably pertinent to the problems Applicants’ invention seeks to solve and thus, Applicants would not be reasonably expected to examine Decker in considering those problems. Nowhere does Decker suggest or even mention any issues or problems regarding the configuration of network access devices for establishing network communications. Therefore, Applicants respectfully request the withdrawal of Decker as a basis of rejection. Additionally, even if combined, neither Decker nor the Examiner’s Official Notice cures the above-identified deficiencies of Merrien. Claims 12, 22 and 35 are thus allowable for at least these reasons.

Even if, without admitting, Decker were in the same field of endeavor as Merrien, the combination of the two references still lacks motivation. The Examiner states the motivation to combine the references would be to “allow for great transmission speeds.” Yet again the Examiner is merely stating the end-result of the combination of Merrien and Decker using impermissible hindsight consideration. Even assuming that any judgment on obviousness is in a

sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant's disclosure. In addition, it is unclear how or why Decker would be motivated to use Merrien to increase transmission speeds considering Merrien offers no disclosure regarding transmission speeds or the enhancement thereof. Merrien similarly lacks any teaching or suggestion of greater transmission speeds, or even transmission speeds in general. Claims 12, 22 and 35 are thus allowable for this additional reason.

Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and Examiner's Official Notice and further in view of Langfahl, Jr. (U.S. Patent No. 6,031,528) (hereinafter "Langfahl").

Claim 31 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and further in view of Langfahl.

These rejections in view of Langfahl are respectfully traversed for the following reasons.

To establish *prima facie* obviousness, the prior art reference (or references when combined) must teach or suggest all claim limitations. MPEP § 2143. Even if combined, the cited references fail to teach or suggest all of the limitations of claims 1 and 27. Nowhere does Langfahl teach or even suggest configuring a network access device using configuration settings such that network communication is established between the network access device and a network operator. Langfahl merely discloses a diagnostic tool that tests the connectivity from the computer to a selected network entity. *See* Abstract. Neither Examiner's Official Notice nor Langfahl cures the deficiencies of Merrien. Claims 20 and 31 are thus allowable for at least the same reasons as their respective base claims.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and Liu and further in view of Kaycee *et al.* (U.S. Patent No. 5,889,470) (hereinafter "Kaycee").

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and Liu and Examiner's Official notice and further in view of Kaycee.

These rejections in view of Kaycee are respectfully traversed for the following reasons.

Kaycee generally relates to a digital subscriber line (DSL) access device management information base (MIB). *See* Abstract. In particular, Kaycee discloses remote management of a DSL access device by using a constructed enterprise DSL MIB. *Id.*

As stated previously with respect to claims 23 and 25-26, there is no motivation to combine Merrien and Liu. As such, even in combination with Merrien, Kaycee fails to cure the deficiencies of Merrien. Additionally, the Examiner fails to provide any motivation to combine Kaycee and Merrien. The Office Action states that the motivation to combine the two systems would have been to allow remote access of the DSL access device. However, Merrien is entirely unrelated to DSL or DSL access devices, much less remote management of such devices. The Examiner is merely using Applicants' invention as a blueprint to combine the references. Such reasoning constitutes impermissible hindsight. Claims 4 and 24 are thus allowable for at least these reasons.

Claims 37 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien and Liu and Examiner's Official Notice and further in view of Langfahl and Riggins.

Claim 38 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien and Liu and Examiner's Official Notice and Langfahl and Riggins and further in view of Kaycee.

Claim 39 stands rejection under 35 U.S.C. §103(a) as being unpatentable over Merrien and Liu and Examiner's Official Notice and Langfahl and Riggins and further in view of Decker.

These rejections are respectfully traversed for the following reasons.

Claim 37 recites, *inter alia*, "a data storage card writer in communication with a network operator, such that said network operator can load configuration settings, diagnostic routines, and encryption data for the subscriber into a smart card via said data storage card writer." Merrien fails to teach or suggest such a feature. At most, Merrien teaches inserting a smart card into a card reader connected to a terminal. *See* Abstract. Nowhere does Merrien suggest a data storage card writer in communication with a network operator much less configuration settings, diagnostic routines and/or encryption data. Examiner concedes the insufficiency of Merrien and seeks to cure the deficiencies of Merrien by erroneously applying several references.

As previously discussed, the combination of Merrien and Liu lacks motivation and therefore is an improper basis for rejection. Riggins, on the other hand, does not satisfy the

analogous arts requirement and is also an improper basis for rejection. Moreover, neither Examiner's Official Notice nor Langfahl cure the deficiencies of Merrien. Claims 37 and 40 are thus allowable for at least these reasons.

With regard to claim 38, Applicants respectfully traverse this rejection for the same reasons as claims 37 and 40 and further for the lack of motivation to combine Kaycee and Merrien as discussed above.

The bases for rejection of claim 39 are substantially the same as for claims 37 and 40. As such, Applicants respectfully traverse the rejection of claim 39 for the same reasons as discussed with respect to claim 37 and 40 and for the additional reason that Decker is not analogous art.

Claims 37-40 are thus allowable for at least these reasons.

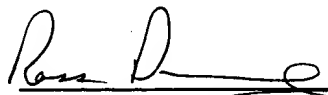
CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully requests prompt notification of the same. If there are any questions, the examiner is invited to contact Applicants' undersigned representative at the number noted below.

Respectfully submitted,

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